

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

NEW YORK MEDIA LLC,
a Delaware limited liability company,

Plaintiff,

NO.: 2:15-cv-1214

COMPLAINT

v.

CUT LLC,
a Delaware limited liability company,

Defendant.

Plaintiff, New York Media LLC (“New York Media” or “Plaintiff”), by its undersigned counsel, alleges:

ALLEGATIONS APPLICABLE TO ALL CLAIMS

1. This is a complaint for an injunction, damages, and other appropriate relief to stop Defendant Cut LLC from infringing New York Media’s trademarks by using a mark that is confusingly similar to New York Media’s trademarks, and by using this mark in bad faith to profit from the good-will associated with New York Media and its trademarks. By this action, New York Media asserts violations of § 32 of the Lanham Act, 15 U.S.C. § 1114 (Trademark Infringement), §43 of the Lanham Act, 15 U.S.C. § 1125 (False Designation of Origin and

1 Trademark Dilution), trademark and unfair competition common law, and the Washington
2 Consumer Protection Act, Chapter 19.86 RCW.

3 **THE PARTIES**

4 2. Plaintiff, New York Media LLC, is a Delaware limited liability company, having
5 its executive offices and place of business at 75 Varick Street, 4th Floor, New York, New York
6 10013.

7
8 3. Upon information and belief, defendant, Cut LLC (“Cut” or “Defendant”), is a
9 Delaware limited liability company, having its principal office and place of business at 1525
10 4th Avenue, Suite 700, Seattle, Washington, 98101.

11 **JURISDICTION AND VENUE**

12 4. This Court has subject matter jurisdiction over the claims in this action arising
13 under the Lanham Act relating to trademark infringement, false designation of origin, and
14 dilution pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338. Upon information and
15 belief, this Court also has subject matter jurisdiction pursuant to 28 U.S.C. § 1332 because the
16 amount in controversy exceeds \$75,000 exclusive of interest, fees and costs, and complete
17 diversity exists between New York Media and Defendant.

18
19 5. This Court has supplemental jurisdiction over the claims in this Complaint arising
20 under state common law pursuant to 28 U.S.C. § 1367(a), because the state law claims are so
21 related to the federal claims that they form part of the same case or controversy and derive from a
22 common nucleus of operative facts.

23
24 6. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) and
25 1400.

New York Media's Brands

9. Since publication of *New York* magazine began in 1968, New York Media has earned worldwide renown as a trailblazer in the field of lifestyle journalism. *New York* magazine covers and comments on news, culture, entertainment, lifestyle, fashion, and personalities for a New York and international audience.

10. *New York* magazine has received extensive acclaim from its readers and journalistic peers. The publication has been consistently honored for its excellence by the National Magazine Awards, winning three awards in 2015, three awards in 2014, and the coveted Magazine of the Year award in 2013.

11. New York Media was among the first traditional print publishers to successfully launch and brand an innovative online presence in the form of topical blogs and websites. New York Media's internet portfolio includes *thecut.com* ("The Cut"), which focuses on the topics of women's lifestyle, fashion, and beauty through a lens of intelligence, sophistication, and humor.

12. The Cut has become a global destination that combines the beauty of a high-end fashion magazine with the dynamic energy and immediacy of the internet. The website averages over 8.6 million viewers per month.

1 New York Media's Intellectual Property

2 13. The New York Media brand encompasses several different trademarks for The
3 Cut's beauty, fashion, and women's lifestyle-related content, including those listed below
4 (together, the "THE CUT Trademarks"), each of which is owned by New York Media:

- 5 • U.S. Trademark Registration No. 3,760,960 effective March 16, 2010 for the
6 word mark "THE CUT" for blogs and online journals featuring content
7 regarding fashion.
- 8 • U.S. Trademark Registration No. 4,682,234 effective February 3, 2015 for the
9 word mark "THE CUT" for the organization for promotional events related to
10 fashion, including fashion shows.
- 11 • U.S. Trademark Registration No. 4,722,777 effective April 21, 2015 for the
12 word mark "THE CUT" for magazine columns featuring news and
13 commentary relating to fashion, beauty, culture, and women's lifestyle.
- 14 • U.S. Trademark Registration No. 4,722,778 effective April 21, 2015 for the
15 word mark "THE CUT" for computer application software for mobile devices,
16 namely, software for viewing content regarding fashion, beauty, culture and
17 women's lifestyle.
- 18 • U.S. Trademark Registration No. 4,722,781 effective April 21, 2015 for the
19 word mark "THE CUT" for entertainment services, including providing a
20 website featuring news, commentary, and photography relating to fashion,
21 beauty, and women's lifestyle.

22 14. These registrations and the trademark registered are valid and subsisting.

23 The Goodwill and Fame of the THE CUT Trademarks

24 15. New York Media has extensively advertised and promoted the THE CUT
25 Trademarks.

26 16. As set forth above, New York Media has also been an important innovator in print
and online journalism.

17. New York Media takes great care and applies the highest level of professional
skill in the creation of content for *New York* magazine and its online portfolio, including The Cut.

1 18. New York Media has invested millions of dollars over the years in marketing,
2 promoting, and advertising the THE CUT Trademarks, which have been in use by New York
3 Media in connection with fashion, beauty, culture, and women's lifestyle content since as early
4 as 2006. The THE CUT Trademarks primarily serve as a designator of the source of information
5 originating from and/or associated with New York Media.
6

7 19. As a result of the foregoing, New York Media has established an internationally-
8 recognized brand and a reputation for the high quality of journalism produced under or in
9 connection with its trademarks, including the THE CUT Trademarks. The THE CUT
10 Trademarks are inherently distinctive, and have acquired secondary meaning and invaluable
11 goodwill in this district, the United States, and around the world.
12

13 20. THE CUT has about 3 million followers on social media sites. There have been
14 over 230,000 subscribers to THE CUT's newsletter. In 2013, THE CUT was awarded a Gold
15 Medal for Website Design from the Society of Publication Designers.

16 Defendant's Infringement of the THE CUT Trademarks

17 21. Upon information and belief, Defendant is a video production company that
18 creates content for distribution on its website and via various social media websites, including
19 YouTube, Twitter, and Facebook.
20

21 22. Long after New York Media adopted and commenced using the THE CUT
22 Trademarks in commerce (and obtained a federal registration for that trademark for blogs and
23 online journals featuring content regarding fashion and beauty), Defendant commenced
24 publishing content on the internet associating that content with the word "CUT" (the "CUT"
25 mark) and cut.com in a manner that has caused, is causing, and is likely to continue to cause
26

1 reasonably prudent consumers to believe that Defendant's content is somehow associated with or
2 sponsored by New York Media.

3 23. Specifically, Defendant is advertising, marketing, distributing, and associating its
4 content with the CUT mark. Among the content in connection with which Defendant uses the
5 CUT mark as a source identifier is an online video series titled "100 Years of Beauty," which
6 relates to women's fashion, beauty, and culture.
7

8 24. Upon information and belief, Defendant began distributing the "100 Years of
9 Beauty" video series under the CUT mark in or about November of 2014, nearly eight years after
10 New York Media began use of the THE CUT Trademarks in commerce.

11 25. Upon information and belief, Defendant was aware of New York Media's use of
12 the THE CUT Trademarks, including in connection with fashion and beauty content, at the time
13 that it began distributing content, including the "100 Years of Beauty" video series, under the
14 CUT mark
15

16 26. Upon information and belief, Defendant's video series, including "100 Years of
17 Beauty," are made available on Defendant's website *cut.com* as well as via social media websites
18 on which it presents content including YouTube, Twitter, and Facebook.

19 27. Upon information and belief, Defendant competes with New York Media's
20 *thecut.com* for visitors, and the "100 Years of Beauty" video series is marketed to substantially
21 the same viewers as The Cut.
22

23 28. Upon information and belief, the scope and demographics of Defendant's target
24 and actual audiences are substantially similar to those of New York Media, and Defendant's use
25 of the CUT mark is confusing, misleading, and deceptive as to the source of its content and is
26

1 misleading the public to believe that the content has been sponsored, approved, authorized, or
2 licensed by New York Media and will continue to confuse, mislead, and deceive unless enjoined.

3 29. New York Media is aware of numerous instances in which the “100 Years of
4 Beauty” video series has been actually confused as being associated with New York Media and
5 the THE CUT Trademarks. This confusion includes (i) several well-known and frequented
6 websites associating the “100 Years of Beauty” video series with New York Media’s The Cut
7 and even directing readers to *thecut.com*, (ii) media tracking services associating videos from
8 Defendant with New York Media, and (iii) twitter posts associating a video from the “100 Years
9 of Beauty” video series with The Cut and New York Media.

10
11 30. New York Media has been vigilant in protecting its trademark rights and has
12 actively sought to correct the misattributions of which it has become aware. New York Media
13 has had to directly contact numerous reputable media websites to correct this actual confusion,
14 including *Elle.com*, *Marie Claire.com*, *HelloGiggles.com*, *Mashable.com*, *Viral Women.com*, and
15 *Bustle.com*.

16
17 31. Defendant has neither sought nor received a license from New York Media to
18 authorize Defendant’s use of the confusingly similar CUT mark.

19 32. Defendant has benefitted from the promotion and distribution of content under the
20 confusingly similar CUT mark. In addition to improperly and wrongly associating its content
21 with New York Media and the THE CUT Trademarks, Defendant has, upon information and
22 belief, earned substantial revenues in excess of \$75,000 as a result of members of the public
23 viewing the “100 Years of Beauty” video series and other videos and content posted by
24 Defendant under the mistaken belief that the videos and content are sponsored by or otherwise
25 associated with New York Media and The Cut.
26

1 33. New York Media sent Defendant a letter on May 12, 2015 demanding that
2 Defendant cease and desist use of the CUT mark as a source identifier for the “100 Years of
3 Beauty” video series and all other content related to fashion, beauty, and women’s lifestyle.

4 34. Defendant responded to New York Media’s letter, but refused to stop using the
5 CUT mark.
6

7 35. New York Media’s counsel sent further communications to Defendant’s counsel
8 demanding that Defendant cease and desist use of the CUT mark as a source identifier for the
9 “100 Years of Beauty” video series and all other content related to fashion, beauty, and women’s
10 lifestyle on May 26 and June 22, 2015.

11 36. Notwithstanding New York Media’s repeated demands that Defendant cease and
12 desist from infringing New York Media’s THE CUT Trademarks, Defendant continues to
13 infringe New York Media’s trademark rights by confusing, misleading, and deceiving the public
14 as to the source and/or sponsorship of the content Defendant distributes with the CUT mark,
15 including installments of the “100 Years of Beauty” video series.
16

17 37. Defendant’s activities are likely to cause and have already caused confusion,
18 mistake, and deception as to the affiliation, connection, and association of Defendant to New
19 York Media, and as to the origin, sponsorship, or approval of the content distributed by
20 Defendant.
21

22 38. These actions and conduct of Defendant have damaged New York Media in an
23 amount to be proven at trial and will, unless restrained, further irreparably impair the value of
24 New York Media’s registered marks and the goodwill associated therewith, for which New York
25 Media has no adequate remedy at law.
26

CLAIM I

REGISTERED TRADEMARK INFRINGEMENT

15 U.S.C. § 1114

39. New York Media repeats and realleges each of the allegations set forth in paragraphs 1 through 38 above.

40. Despite knowledge of New York Media's pre-existing rights, Defendant has used and continues to use the CUT mark in connection with the advertising and distribution of Defendant's content, including installments of the "100 Years of Beauty" video series. Such use has caused, is causing, and will continue to cause confusion, mistake, and deception among consumers.

41. Defendant's actions constitute willful and deliberate infringement of New York Media's THE CUT Trademarks in violation of § 32 of the Lanham Act, 15 U.S.C. § 1114.

42. By virtue of Defendant's wrongful acts and conduct, including trademark infringement, Defendant has received money and profits that it would not have received and/or rightfully would have been received by Plaintiff.

43. Defendant's continued use of the CUT mark in disregard of New York Media's cease and desist letters makes this an exceptional case within the meaning of 15 U.S.C. § 1117.

44. As a direct and proximate result of Defendant's conduct, New York Media has suffered irreparable harm to the valuable THE CUT Trademarks, and other damage in an amount to be proven at trial. Pursuant to 15 U.S.C. § 1117, Plaintiff is further entitled to enhanced damages and/or attorneys' fees and costs. New York Media has no adequate remedy at law that will compensate it for the continued and irreparable harm it will suffer if Defendant's actions are allowed to continue. New York Media thus seeks preliminary and permanent injunctive relief.

1 45. Although insufficient to fully remedy the damage suffered by New York Media as
2 a result of Defendant's wrongful conduct, New York Media is also entitled to recover from
3 Defendant all moneys wrongfully received as a result of infringing New York Media's THE
4 CUT Trademarks.

5
6 **CLAIM II**

7 **FALSE DESIGNATION OF ORIGIN AND SPONSORSHIP**
8 **15 U.S.C. § 1125(A)**

9 46. New York Media repeats and realleges each of the allegations set forth in
10 paragraphs 1 through 45 above.

11 47. Defendant's use of the CUT mark in commerce in connection with the distribution
12 of its content, including the "100 Years of Beauty" video series, was and is a knowing and
13 intentional infringement of New York Media's trademark rights in the THE CUT Trademarks,
14 including in connection with fashion and beauty content.

15 48. Defendant's use of the CUT mark in commerce in connection with the distribution
16 of its content, including the "100 Years of Beauty" video series, has, is, and will cause confusion,
17 mistake, and deception as to the affiliation, connection, association, or endorsement of Defendant
18 and its content, including the "100 Years of Beauty" video series, with New York Media. Upon
19 information and belief, such confusion will cause Plaintiff to lose viewers and business due to
20 this consumer confusion caused by Defendant, thereby causing loss, damage, and irreparable
21 injury to Plaintiff and the purchasing public.

22 49. By virtue of Defendant's wrongful acts and conduct, including false designation
23 of origin and sponsorship, Defendant has received money and profits that it would not have
24 received and/or rightfully would have been received by Plaintiff.
25
26

50. Defendant's actions constitute willful and intentional use, appropriation, and infringement of the THE CUT Trademarks in disregard of New York Media's rights in violation of 15 U.S.C. §1125(a).

51. As a direct and proximate result of Defendant's conduct, New York Media has suffered irreparable harm to the valuable THE CUT Trademarks, and other damage in an amount to be proven at trial. Pursuant to 15 U.S.C. § 1117, Plaintiff is further entitled to enhanced damages and/or attorneys' fees and costs. New York Media has no adequate remedy at law that will compensate it for the continued and irreparable harm that it will suffer if Defendant's actions are permitted to continue. New York Media thus seeks preliminary and permanent injunctive relief.

52. Although insufficient to fully remedy the damage suffered by New York Media as a result of Defendant's wrongful conduct, New York Media is also entitled to recover from Defendant all moneys wrongfully received as a result of its false designation of the origin and sponsorship of its content.

CLAIM III

TRADEMARK DILUTION
15 U.S.C. § 1125(C)

53. New York Media repeats and realleges each of the allegations set forth in paragraphs 1 through 52 above.

54. New York Media has extensively and continuously promoted and used the THE CUT Trademarks in the United States and internationally and the marks have thereby become a famous and well-known symbol of New York Media's fashion, beauty, and women's lifestyle-related content.

55. Despite knowledge of New York Media’s famous trademarks, Defendant used and continues to use in commerce an imitation thereof in connection with the advertisement, promotion, and distribution of its content, including the “100 Years of Beauty” video series.

56. Defendant is making commercial use of the marks that dilutes and is likely to dilute the distinctiveness of New York Media's THE CUT Trademarks by eroding the public's exclusive identification of these famous marks with New York Media and lessening the capacity of the marks to identify and distinguish New York Media's content.

57. Defendant's actions demonstrate a willful intent to trade on the goodwill associated with New York Media's THE CUT Trademarks and dilution of the distinctiveness and value of New York Media's famous THE CUT Trademarks in violation of 15 U.S.C. § 1125(c).

58. As a direct and proximate result of Defendant's conduct, New York Media has suffered irreparable harm to the valuable THE CUT Trademarks, and other damages in an amount to be proven at trial. Pursuant to 15 U.S.C. § 1117, Plaintiff is further entitled to enhanced damages and/or attorneys' fees and costs. New York Media has no adequate remedy at law that will compensate it for the continued and irreparable harm that it will suffer if Defendant's actions are permitted to continue. New York Media thus seeks preliminary and permanent injunctive relief.

CLAIM IV

COMMON LAW TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION

59. New York Media repeats and realleges each of the allegations set forth in paragraphs 1 through 58 above.

1 66. Unless the foregoing alleged actions of Defendant are enjoined, New York Media
2 will continue to suffer irreparable injury and damage. Accordingly, Plaintiff should be awarded
3 preliminary and permanent injunctive relief, treble damages, and costs, including reasonable
4 attorneys' fees, under RCW § 19.86.090.

5 WHEREFORE, Plaintiff demands:

6 1. That Defendant, its officers, agents, servants, employees, and attorneys, and
7 those in active concert or participation with them or any of them, be preliminarily and
8 permanently enjoined and restrained:
9

10 (a) From using in any manner the CUT mark alone or in combination with any
11 other words or designs, in any manner likely to cause confusion, deception, or
12 mistake on or in connection with advertising or distribution of any fashion,
13 beauty, or women's lifestyle-related content not produced by New York
14 Media, or not authorized by New York Media to be distributed in connection
15 with its marks, including the THE CUT Trademarks
16

17 (b) From representing, suggesting in any fashion to any third party, or performing
18 any act that may give rise to the belief that Defendant, or any of its goods, are
19 authorized or sponsored by New York Media;
20

21 and

22 (c) From infringing or diluting New York Media's THE CUT Trademarks;

23 2. That Defendant be ordered to file with the Court and serve upon Plaintiff,
24 within thirty (30) days of the entry of the injunctive relief prayed for herein, a written report
25 under oath or affirmed under penalty of perjury setting forth in detail the form and manner in
26 which it has complied with the injunction;

1 3. That Defendant be required to account to Plaintiff for any and all profits
2 derived by it, and for all damages sustained by Plaintiff by reason of Defendant's actions
3 complained of herein, and that such amount be trebled;

4 4. That Plaintiff be awarded all other damages, including exemplary damages, to
5 the fullest extent available under federal and/or state law;

6 5. That Plaintiff be awarded both pre-judgment and post-judgment interest on
7 each and every damage award;

8 6. That Plaintiff have and recover from Defendant, Plaintiff's reasonable
9 attorneys' fees, costs, and disbursements of this action, including without limitation pursuant
10 to 15 U.S.C. § 1117 and the Washington Consumer Protection Act;

11 7. That Plaintiff have leave to amend these claims to conform to proof later
12 discovered, pled, or offered; and

13 8. That Plaintiff have such other further relief as the Court may deem just and
14 proper.

1 DATED this 31st day of July, 2015.

2
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21 Attorneys for Plaintiff

22 New York Media LLC

DEMAND FOR JURY TRIAL

Plaintiff, New York Media LLC, hereby demands trial by jury of all issues so triable.

Dated: July 31, 2015

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